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OCT 11 1948

Supreme Court of the United States.

OCTOBER TERM, 1948.

No. 343

UNITED SHOE MACHINERY CORPORATION,
Petitioner,

v.

JACOB S. KAMBORIAN
AND
INTERNATIONAL SHOE MACHINE CORPORATION,
Respondents.

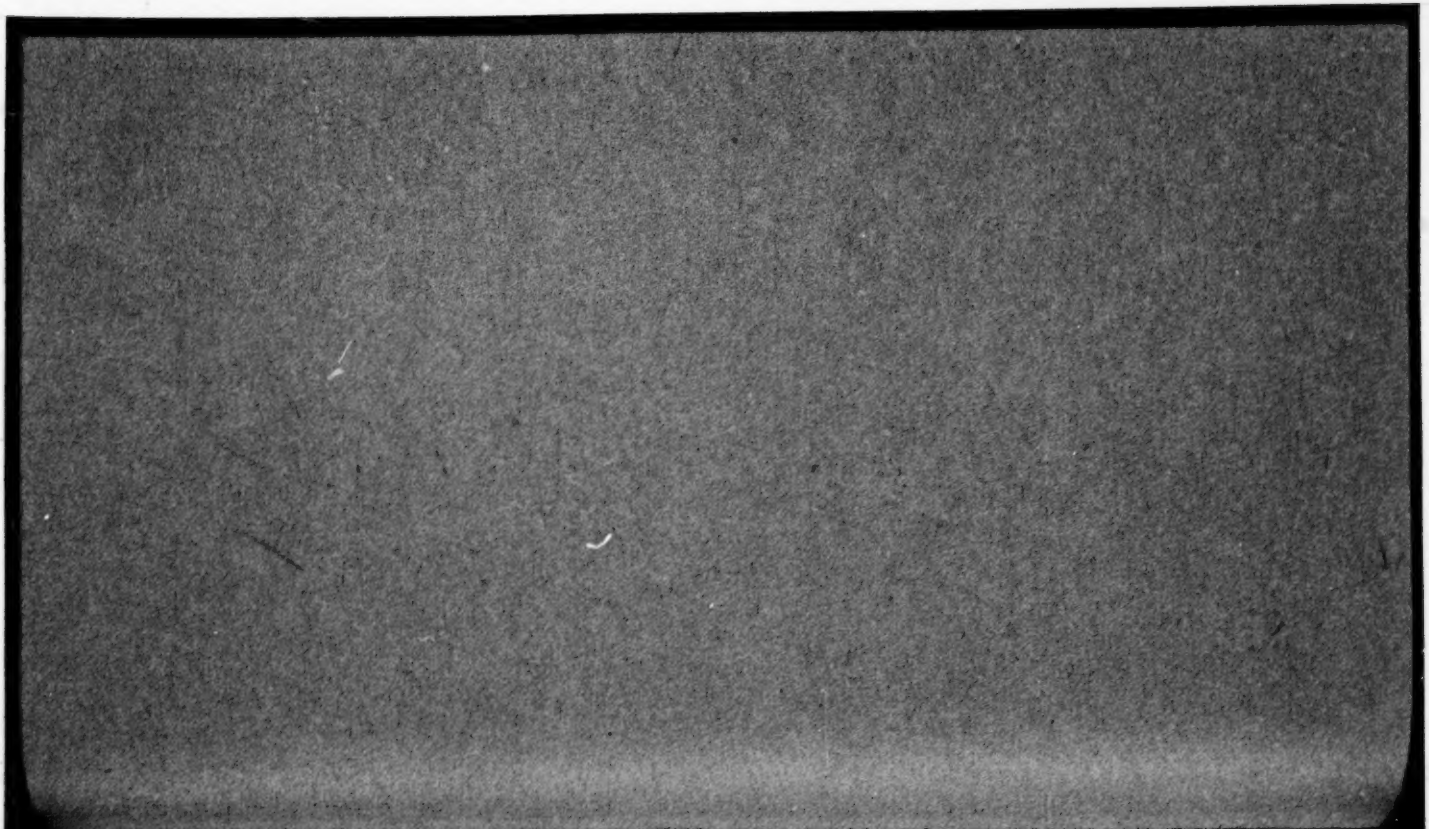
PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

AND

BRIEF IN SUPPORT THEREOF.

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, United Shoe Machinery Corporation, respectfully prays for a writ of certiorari to the United States Court of Appeals for the First Circuit, to review a judgment of that Court entered on or about July 16, 1948, said judgment affirming a judgment of the District Court entered on remand following a previous appeal.

The opinion of the Circuit Court of Appeals on the present appeal appears at RII, 107.* The opinion of the

*We refer herein to the Transcript of the Record on the first appeal as RI, and to the additional Transcript of the Record on the second appeal as RII.

District Court on remand appears at RII, 17, and is reported at 73 Fed. Supp. 548. The opinion of the Circuit Court of Appeals on the first appeal appears at RII, 21, and is reported at 160 Fed. (2d) 461. The original opinion of the District Court appears at RI, 11, and is reported at 62 Fed. Supp. 903.

The jurisdiction of this Court to review said judgment is conferred by Section 1254 of Title 28 of the United States Code.

Summary and Short Statement of the Matters Involved.

Petitioner was defendant below in a suit for infringement of Kamborian Patents Nos. 2,251,284 and 2,254,224 (RI, 27, 183-204), the first being for a machine and the second for a method supposed to be performed by the machine. Except for the claims, the two patents are practically identical, being the result of dividing a single original patent application. Only four of the fifty-five claims of the patents are in suit, being Nos. 26 and 28 of the machine patent No. 2,251,284 and Nos. 13 and 19 of the method patent No. 2,254,224.

THE PATENTS IN SUIT.

The claims in suit are very broad and those pertaining to the machine define the alleged invention in terms of "means" qualified by a statement of the function which the said means are intended to perform. The machine claims 26 and 28 read as follows:

> "26. Shoe lasting apparatus comprising upper stretching means and in-wiping means, the stretching means being designed and arranged positively to grip a narrow area of the margin of the upper and, after stressing the gripped portion of the margin in a direc-

tion substantially perpendicular to the last bottom, to release the gripped area while concomitantly gripping an adjacent area, the wiping means being constructed and arranged to wipe in each area of the margin only after such area has escaped from the stressing means."

"28. Shoe lasting apparatus comprising upper gripping means operative to seize a narrow area of the margin of the upper and positively to stress such margin in a direction substantially perpendicular to the bottom of the last thereby to stretch it snugly about the last, means operative to wipe in a narrow area of the marginal material which has already been stressed and released by the gripping means and closely adjacent to but spaced from a point at which said stress is being concomitantly applied, and means operative to cause relative movement of said stressing and wiping means and the last whereby the points of stressing and wiping progress along the edge of the insole."

The patents in suit describe and illustrate a simple shoe lasting machine comprising stretching means to stretch the shoe upper tightly about a wooden last and in-wiping means to fold the lasting margin of the stretched upper over into facing engagement with an insole on the last, the lasting margin being secured to the insole by suitable fastening means, shown in the patents as adhesive or metallic fasteners. The only stretching means described in the patents is a pair of oppositely rotating rolls, vertically disposed, between which the lasting margin of a shoe upper is securely gripped and fed by rotation of the rolls to the in-wiping means. The in-wiping means disclosed is a conventional reciprocating blade. The de-

scribed machine also includes devices for positioning the shoe laterally and for maintaining the shoe bottom in a horizontal plane normal to the axes of the rolls.

It is old *per se* to employ angularly disposed rolls to feed and tension leather in the making of shoes and very old to employ reciprocating wiper blades in the lasting of shoes. Stretching means and wiping means are, of course, the essential elements of most lasting machines.

However, the rolls of the patents in suit are not angularly disposed, or inclined, to obtain a component of up-pull as the shoe is fed, but the vertical rolls are formed like screws with upwardly spiralling ribs in the roll surfaces. The patents teach that as the rolls rotate "they exert a strong upward stress, by reason of their helical ribs, tending to stretch the upper about the last" (RI, 189, col. 2, ll. 15-17, and RI, 201, col. 2, ll. 18-20). The patents also teach, as indeed the claims require, that these stretching means are operable to stress the gripped portion of the margin in a direction substantially perpendicular to the last bottom, "thereby to stretch it snugly about the last," and that the wiper operates "only after such area has escaped from the stressing means" to wipe in a narrow area of the marginal material "which has already been stressed and released" (Cls. 26 and 28, *supra*, pp. 2, 3).

Not only are the gripper rolls the sole means disclosed in the patents for stressing or tensioning the upper, but also all the claims in suit of both patents are distinctly limited to a machine and method in which the tensioning is produced only before and independently of the wiper.

Thus claim 26 of patent No. 2,251,284 calls for "the wiping means being constructed and arranged to wipe in each area of the margin *only after such area has escaped from the stressing means*"* (gripper rolls) (*supra*, pp. 2, 3).

*Emphasis ours throughout.

Claim 28 of the same patent requires "means operative to wipe in a narrow area of the marginal material *which has already been stressed and released by the gripping means*" (*supra*, p. 3).

Claim 13 of patent No. 2,254,224 provides the steps of "*seizing* a narrow area of the margin of the upper and *applying positive lasting pull thereto,*" and feeding, preliminary to wiping (RI, 203).

Claim 19 of patent No. 2,254,224 calls for "wiping in such portions of the margin *as they are released from the gripping means*" (RI, 203).

These limitations were the price of allowance of the claims. Thus, in the amendment to the application for patent No. 2,251,284, in which claims 26 and 28 were amended by adding the italicized portions of the above-quoted limitations, Kamborian's attorney said (RI, 252):

> "As contrasted with this [prior art] *in applicant's machine, the wiper only engages that part of the upper material which has previously been gripped, stretched and released by the gripping means* (see page 11 of the specification, beginning at line 15)."

Now, it is a fact, recognized by the District Court and accepted by the Court of Appeals, that Kamborian's helically ribbed rolls will not stretch the upper "snugly about the last," as the patents teach and claim, before releasing the stock for engagement by the wiper. Instead, the Courts have found that, although the rolls provide "some" stretch, it is the old wiper, operating in combination with the rolls, that provides the stretch sufficient to do the necessary continuous lasting claimed (RII, 21, 108). Since lasting in this manner is not disclosed in the Kamborian patents, it is submitted that, as a matter of law, the claims in suit ought to have been declared invalid as failing to

comply with the provisions of R.S. Sec. 4888,* which require, as a condition of the patent grant, "in the case of a machine," that the applicant "shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions."

This is not the familiar case of a patentee harmlessly setting forth an erroneous theory of the reasons for the operation of a machine claimed in terms of structure or mechanism. It is a case where, by the use of functional language, the patentee has claimed only an erroneous principle of machine operation and no structure or mechanism whatever.

Petitioner has steadfastly contended and believes that it has proved by a great preponderance of the evidence, contrary to findings of the Courts below, that no lasting, stretching, stressing or tensioning whatsoever can be obtained by the helical ribs of Kamborian's rolls any more than a fly alighting on the surface of a barber pole would be elevated in the course of its ride about the pole's axis.

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*SEC. 4888. (U.S.C., title 35, sec. 33.) "Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible."

All points on the surfaces of the rolls and their ribs necessarily move about the vertical axes of the rolls in horizontal planes. Hence, lifting of the positively gripped shoe stock by the spiral ribs is impossible, and any apparent rise is pure optical illusion. However, a review by this Court of the erroneous findings of the lower Courts on these points, while warranted, is not essential, since the errors of law herein relied upon arise from the facts as found by the lower Courts.

The Accused Machine.

The accused machine consists of a single rotating roll, lacking the helical ribs of the Kamborian rolls, and disposed at an angle to the shoe bottom rather than normal thereto as in the Kamborian patents. The lasting margin of a shoe is spring pressed against the roll by a smooth polished sleeve. The single, unribbed roll thus feeds the stock at an angle upwardly and forwardly, thereby stressing the stock before it is engaged by a chain wiper operating to lay the stressed margin on the shoe bottom, where it is secured by adhesive. Certain novel features of petitioner's accused machine were patented since this suit commenced but on an earlier filed application which resulted in U.S. Patent No. 2,397,369, owned by petitioner. The patented features relate to arrangements which include overdrawing the upper stock after tensioning and before wiping.

The Decisions Below.

The First Decision of the District Court:

The Court held the patents valid and the claims in suit infringed. On the issue of the operability of the helically ribbed rolls to tension, the Court said:

"Kamborian, the patentee, is a man of considerable mechanical ability but his knowledge of mechanical principles and theories has not been demonstrated. At the time that he filed his patent application he was of the opinion—and probably is today—that the introduction of material between such rolls as he describes in his invention would have a tendency to uplift or pull it. . . . Undoubtedly, while there is direct engagement of the cloth between the ribs there may be some such upward pull, but the pull, if any, on the material is not sufficient to completely tension the material to conform to the contour of the wooden last. Such additional tension as may be needed is provided by the operator who exerts pressure by pushing the last inwardly towards the body of the machine, or by presenting the work at an angle to the rotating gripping rolls. The resulting tension is sufficient to do a workmanlike job in conformance with the patent claims. Whether or not Kamborian understood all that his machine would do at the time that he described it in his patent application is immaterial. He is entitled to the benefits of all that he has created. With a few minor improvements, the machines that Kamborian has built read directly on the patents" (RI, 13).*

And the Court remarked that "it is immaterial that the principle of operation is not as described in the patent, . . ." (RI, 14).

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*Significantly, Kamborian has discarded the vertical rolls with helical ribs and has substituted unribbed rolls which are inclined like defendant's roll (RII, 67). The "few minor improvements" referred to by the Court are subject-matter of a subsequent patent to Kamborian, No. 2,251,285, not in suit (RI, pp. 90, 439 and 459).

The First Decision of the Court of Appeals:

The Court of Appeals affirmed the finding of infringement but vacated the judgment and remanded the case to the District Court for further proceedings on the question of validity, saying:

> "While the shoe is in this position these rolls with the helical ribs are supposed to pull up the material and the wiper to smooth it down" (RII, 24).
>
> "It is quite clear in reading the inventor's application as a whole what he had in mind. He had a perfectly integrated theory about combining these various operations into one in his machine. Its fundamental premise was the supposed upward pull of his helical ribs" (RII, 26).
>
> ". . . It is undoubtedly the law that a man is entitled to the benefits of his invention whether his theory in explaining how he got his result is right or not. Thus if he describes a certain process and explains that the result is due to a given chemical change he is entitled to the benefit of the process even though the explanation of the result may be incorrectly stated. But Kamborian's situation is quite different as the statute requires that he describe his machine and tell how to work it. If it does not work as described, that it works some other way is not enough.
>
> "We think that the controlling question is whether Kamborian's helical ribs do what he said they do. We disagree with the learned District Court's statement that if they do not Kamborian even then has produced a machine which conforms to his patent" (RII, 27, 28).

The Second Decision of the District Court:

The District Court, after permitting further trial and demonstration on petition of the plaintiff, again held the claims valid and infringed. The Court stated (RII, 18) that it "completely abandoned" its earlier finding respecting the operation of the helically ribbed rolls and found in answer to questions propounded by the Court of Appeals that, although the helical ribs do provide "some" upward pull, sufficient pull to do the necessary continuous lasting claimed was "provided by the combination of the helical ribs and the wiper" (RII, 20, 21). It will be noted that by this new finding the Court failed to abandon its earlier view that something other than the helical ribs is essential to obtaining lasting tension. In the first opinion it was the operator contributing lasting force, and in the second opinion it was the wiper which was found necessary to perform the stretching function claimed for the helical ribs.

Second Decision of the Court of Appeals:

On the second appeal to the Court of Appeals petitioner contended that, since the District Court had now found the action of the wiper to be an essential part of the "stretching means" of the patents, the claims were void because the patents state unequivocally in their specifications and claims that the stretching is performed by the gripper rolls alone, independently of the wiper. Petitioner further contended that, if the claims in suit were construed as directed to a combination of gripper means and wiper to effect tensioning, petitioner's machine did not infringe, because it operated on the different principle of tensioning by the gripping means alone.

The Court of Appeals, accepting the District Court's findings under Rule 52, overruled petitioner's said conten-

tions and affirmed the judgment of the District Court. The Court, observing that "Kamborian is bound to show how his machine works but not why," held that his burden in that regard was "satisfied" by tests conducted by respondent in the District Court upon which that Court based its finding that the machine of the patents produced lasting tension by combined action of the gripper rolls and wiper.

The Court did not purport to find any disclosure in the patent that the wiper plays any part in tensioning, which would be contrary to fact and to the Court's previous findings that the patent discloses only tensioning by the helically ribbed gripper rolls alone. Instead, the Court merely said that the patents in suit disclose a machine in which the wiper could be made to produce sufficient tensioning in combination with the gripper rolls by adjustments within the realm of mechanical skill.

The second decision of the Court of Appeals, therefore, is in direct conflict with its first decision, wherein the Court said: "If it does not work as described, that it works some other way is not enough" (*supra*, p. 9).

In a footnote to the opinion the Court dismissed petitioner's contention of non-infringement, stating that "The change of finding on what supplies the additional tensioning in the plaintiff's machine . . . is of no legal significance" (RII, 109).

Effects of the Enlargement of the Patents.

If the decision of the Court of Appeals is permitted to stand, it is clear that the scope of the Kamborian patents has been greatly enlarged by this judicial interpretation of their claims. Instead of a machine having two operating instrumentalities working independently, and in sequence, to last the shoe, first stressing means and then wiping means, as the language of the claims clearly de-

fines, the patents must now be understood to embrace a machine in which both means work *in combination* to obtain the stressing function.

More seriously, in view of the holding of infringement by petitioner's single unribbed roll and chain wiper machine, the claims might now be interpreted as infringed by all conceivable combinations of structures capable of performing the described lasting and wiping functions, whether such structures operated in sequence or in combination with each other, and whether now known or still in the realm of future invention.

In petitioner's machine it is the inclined roll alone that obtains the lasting tension, and respondents relied heavily on this fact in establishing infringement at the trial. If, as the Court of Appeals has found, Kamborian's real invention was the tensioning by a combination of the rolls and wiper, then petitioner has been unjustly convicted of infringement.

Questions Presented.

1. Are patent claims valid despite the fact that the patents explain an erroneous principle of a machine and the claims define only said erroneous machine principle?

2. Where patent claims define mechanism only as means qualified by a statement of the function which the said means are intended to perform, are the claims valid when it is found that the only mechanism described by the patentee for performing the function is in fact incapable of performing it?

3. Where the language is clear and unmistakable, and there is no ambiguity to be resolved, may the meaning of patent claims be changed by judicial interpretation to save their validity, even though such change nullifies amend-

ments which were essential to the allowance of the claims by the Patent Office?

4. Where patent claims are prima facie infringed, does infringement in fact exist when, to save their validity, the claims are judicially construed as defining a machine principle different from the principle of the accused machine? Must not the claims receive the same interpretation for the purpose of finding infringement as for finding validity?

Reasons Relied upon for the Allowance of the Writ.

Petitioner believes that writ of certiorari should be granted in this case for the following reasons, and accordingly the discretionary power of this Court is invoked:

1. The Circuit Court of Appeals has decided the following important questions of Federal law which have not been, but should be, settled by this Court:

a. That claims of a patent are valid despite the fact that the patent sets forth an erroneous explanation of the principle of a machine and said claims define only said erroneous machine principle. (R.S. Sec. 4888 requires that in the case of a machine the patent "shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions.") (*Supra*, p. 6.)

b. That claims of a patent are valid despite the fact that the claims define means for performing a function which the disclosed means is incapable of performing.

c. That, although the language of a patent is clear and unmistakable, and there is no ambiguity to be resolved, the meaning of the patent claims may be changed by judicial interpretation to save their valid-

ity, even though such change nullifies amendments which were essential to the allowance of the claims by the Patent Office.

d. That patent claims may be construed as defining one machine principle for the purpose of saving their validity, and as defining a different machine principle for the purpose of establishing their infringement.

2. The Circuit Court of Appeals has decided each of the following Federal questions in a way probably in conflict with applicable decisions of this Court:

a. That a patent can be interpreted as disclosing and claiming a combination of two means co-acting to perform a designated function and nevertheless be held infringed by a machine in which said function is performed by a single means.

Westinghouse v. *Boyden Power Brake Co.*, 170 U.S. 537.

b. That claims of a patent which recite only "means" qualified by statements of function are not invalid for failure to comply with the provisions of R.S. Sec. 4888.

United Carbon Co. v. *Binney & Smith Co.*, 317 U.S. 228.

Halliburton Oil Well Cementing Co. v. *Walker*, 329 U.S. 1.

3. Further litigation which could result in a conflict of opinion between the Courts of Appeals of different circuits is unlikely as the shoe machinery industry here affected is concentrated in the First Circuit.

Schriber-Schroth Co. v. *Cleveland Trust Co.*, 305 U.S. 47, 50.

MacKay Radio & Telegraph Co. Inc. v. *Radio Corporation of America*, 306 U.S. 86, 89.
Exhibit Supply Co. v. *Ace Patents Corp.*, 315 U.S. 126, 128.
Muncie Gear Works, Inc., v. *Outboard, Marine & Manufacturing Co.*, 315 U.S. 759, 766.

4. The Circuit Court of Appeals has rendered two conflicting decisions in this case respecting the proper application of a Federal law (R.S. Sec. 4888). Although these separate conflicting decisions were rendered by the same Court, they were rendered at different times and the personnel of the Court was not identical on both occasions. It is therefore submitted that the spirit, if not the letter, of the Supreme Court Rule 38, Sec. 5, Par. *b*, is applicable.

Respectfully submitted,

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BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

I.

The Decisions Below Sustain Claims Defining Only an Erroneous Machine Principle.

The question whether patent claims which define only an erroneous explanation of the principle of a machine may be sustained as valid is an important one which apparently has never engaged the attention of this Court. The statute (R.S. Sec. 4888)* requires that in the case of a machine the principle thereof shall be explained. The question arises in this case because—

a. The findings of the Courts below conclusively establish that the patentee has erroneously described how his machine operates and he has based his claims entirely on his erroneous theory; and

b. The Courts below have sustained the claims in suit as valid on fact findings to the effect that, with certain minor changes within the capacity of a skilled mechanic, the machine of the patents may be made to operate in accordance with a different machine principle not described, explained or even contemplated by the patentee.

The patents in suit describe the operation of the machine as based upon tensioning by the helically ribbed gripper rolls and subsequent, independent wiping action by the wiper. The patents say, "as the gripper rolls 36 and 37 rotate, they exert a strong upward stress, by reason of their helical ribs, tending to stretch the upper about the last" (*supra*, p. 4). The Court of Appeals found in its first opinion: "In Kamborian's words, 'the marginal ma-

*Quoted at page 6, *supra*.

terial of the forepart and sides is first drawn upwardly in a direction substantially perpendicular to the bottom of the insoles and then . . . is wiped in over the edge of the insole into smooth contact with the latter; . . .' *The perpendicular stress is supposed to come from two gripper rolls*" (RII, 22). And again: "While the shoe is in this position these rolls with the helical ribs are supposed to pull up the material and the wiper to smooth it down" (RII, 24).

In their second opinions both the District Court and the Circuit Court of Appeals have found that the gripper rolls, the "tensioning means" of the patents, will not of themselves supply the requisite lasting tension as the patentee thought, but instead that his machine requires, in order to last a shoe, tensioning by conjoint simultaneous action of the gripper rolls and the wiper. The District Court found that "the pull provided by the *combination* of the helical ribs *and the wiper* . . . is sufficient to do the necessary continuous lasting claimed by the invention" (RII, 21), and the Court of Appeals approved this finding, saying that "these opposite forces [gripper rolls and wiper] must necessarily result in a stretching of the material therein engaged" (RII, 111).

These findings conclusively establish that Kamborian has erroneously described how his machine operates.

In its second opinion, the Court of Appeals did not purport to find any disclosure in the Kamborian patents that the wiper aids in producing tension. The Court merely said "the wiper is intended to be in such a position that it engages the leather before all of it has cleared the gripper rolls," and that in such case tensioning by conjoint action of the gripper rolls and the wiper "must necessarily result" (RII, 111).

The erroneous principle of operation of the Kamborian machine described in the patents was carried into the

claims in suit by amendments made to distinguish from the prior art (*supra*, p. 5).

In upholding Kamborian's claims in suit, the Court of Appeals adverts to two decisions of this Court—*Eames* v. *Andrews*, 122 U.S. 40, and *Diamond Rubber Co. of New York* v. *Consolidated Rubber Tire Co.*, 220 U.S. 428. These cases are referred to as supporting the proposition, cited by the Court of Appeals, that "The physical or mechanical law which makes this machine operate in a certain way is interesting but is immaterial patentwise" (RII, 110).

This proposition is supported by the cases cited; but neither the proposition nor the cases cited in support of it are decisive of the issue of the validity of the claims in suit under R.S. Sec. 4888 (*supra*, p. 6). It may be true, as stated in the Diamond Rubber case (*supra*), that it is not necessary for the inventor to "understand or be able to state the scientific principles underlying his invention," but this is not to say that the statute does not require the inventor to describe accurately *how* his machine operates. It merely says that it is immaterial whether or not he explains accurately *why* it so operates.

In other words, Kamborian is not in the position of a patentee who has correctly described how his machine operates, but has set forth an incorrect theory of the physical or mechanical laws which make it operate in the way it is described. On the contrary, on the findings in the lower Courts, the patentee has erroneously described how his machine works and has claimed it in terms of that erroneous explanation. This Court has recently had occasion to condemn claims drawn broadly in terms of means and their functions. *Halliburton Oil Well Cementing Company* v. *Walker*, 329 U.S. 1. Here, not only are the claims drawn in such terms, but the functions set forth are erroneous.

In *Beidler* v. *United States*, 253 U.S. 447, 453, this Court found the claims invalid as failing to define a "useful"

invention within the meaning of R.S. Sec. 4886. However, this Court there referred at length to the requirements of R.S. Sec. 4888, and said:

> "Ever since *Grant* v. *Raymond,* 6 Pet. 218, 247, it has been consistently held that a correct and adequate description or disclosure of a claimed discovery (which, in the case of a machine, involves particularly the operation of it) is essential to the validity of a patent."

Thus this Court has clearly stated that the statute requires the patentee to describe correctly the operation of his machine. This Kamborian has not done.

Although the Court of Appeals, in its second decision in the case, recognized that under the statute "Kamborian is bound to show how his machine works," the Court held his burden in that respect satisfied because it found that the directions given in his patent for operating his machine were sufficient (RII, 109). The Court thus interpreted the statute as requiring only that Kamborian describe how to operate his machine, not how the machine operates.

Petitioner submits that R.S. Sec. 4888, will not bear this interpretation. It requires not only that the principle of a machine shall be explained, but also that, as to any invention, including a machine, the application shall set forth the "process of making, constructing, compounding, *and using it.*" Thus the "principle" of the machine, which the statute says must be explained, is necessarily something different from the manner of using the machine, which the statute also says must be explained, and must be, as stated by this Court in the Beidler case, the manner in which the machine operates.

II.

The Courts Below have Eliminated from the Claims, by Interpretation, Express Limitations to an Erroneous Principle of Operation.

Kamborian's erroneous theory that his gripper rolls alone would provide the requisite lasting tension was carried into his claims in suit by amendments which state that the wiper acts only after the "stressing means" (gripper rolls) have applied the lasting tension, thereby expressly excluding the wiper as any part of the tensioning means (*supra*, p. 5). These limitations were the price of allowance of the claims, Kamborian's attorney asserting that the prior art was thereby distinguished because "the wiper only engages that part of the upper material which has previously been gripped, stressed and released by the gripping means" (*supra*, p. 5).

The lower Courts have found, as previously pointed out (*supra*, pp. 5, 17), that the requisite lasting tension in Kamborian's machine is only obtained by conjoint action of the gripper rolls and the wiper. Thus, upon the findings of the Courts below, Kamborian obtained his claims in suit for an invention which he did not make.

Nevertheless, the Courts below have, in effect, eliminated these limitations of the claims by interpreting the claims as if they were drawn to a combination of gripping means and wiper to obtain tension, which the Courts have found to be the actual principle upon which the Kamborian machine can be made to operate.

This Court has indicated that "in a proper case a claim may be upheld by reference to the descriptive part of the specification in order to give definite content to elements stated in the claim in broad or functional terms" *General Electric Co.* v. *Wabash Appliance Corp.*, 304 U.S. 364, 373. Obviously, this is not such a case, not only because the

terminology of the claims is plain and requires no interpretation, but also because the specifications of Kamborian's patents completely failed to indicate that the wiper has any part in tensioning and instead said plainly that the tensioning is accomplished only by the gripper rolls.

On the other hand, this Court has held that "limitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and looked upon as disclaimers." *Smith* v. *Magic City Kennel Club, Inc.*, 282 U.S. 784, 790. This rule appears to have been applied by this Court heretofore only in cases in which the patentee was seeking to broaden his claim to include as an infringement a device which was excluded by the amendment. Petitioner submits, however, that the rule was intended to be of broader application and to forbid any interpretation of claims which eliminates express limitations added to the claims as the price of allowance, whether for the purpose of sustaining the claims or of holding them infringed.

Petitioner further submits that, once an applicant has restricted his claims by amendment to a given principle of operation, a Court may not interpret those claims as defining an invention involving a different principle of operation and that this is an important question of patent law which should be settled by this Court.

III.

The Interpretation of the Claims on Which the Court Found Them Valid Excludes the Machine Alleged to Infringe.

If Kamborian's machine claims had accurately described his invention as involving a combination of wiper and gripper means to obtain tensioning, petitioner's machine would clearly not have infringed. For it was shown by

respondents' own proofs that in petitioner's machine the tensioning is accomplished by the inclined gripper roll alone and not by its co-action with the wiper (RI, 80, 81).

Petitioner's machine, therefore, would not infringe claims drawn to a combination of gripper means and wiper to effect tensioning, both because petitioner's machine operates upon a different principle and because one element of such claimed combination would be missing in petitioner's machine. *Westinghouse* v. *Boyden Power Brake Co.*, 170 U.S. 537.

The Court of Appeals has sustained Kamborian's claims by interpreting them as if they called for tensioning by a combination of gripping means and wiper, although they are expressly limited to a machine in which tensioning is accomplished by means independent of the wiper. Yet the Court also holds the claims infringed by a machine in which the tensioning is accomplished independently of the wiper. Thus, by failing in his claims to describe accurately the invention, Kamborian is permitted to cover not only the invention which it is found he did make but also an invention which it is found he did not make.

In *Halliburton Oil Well Cementing Co.* v. *Walker*, 329 U.S. 1, this Court said (at page 13):

> "Certainly, if we are to be consistent with Rev. Stat. 4888, a patentee cannot obtain greater coverage by failing to describe his invention than by describing it as the statute commands."

In holding Kamborian's claims both valid and infringed the Court of Appeals has allowed Kamborian to do exactly what this Court so condemned in the Halliburton case.

Petitioner submits that the holdings of the Courts below as to infringement conflict with the decisions of this

Court as set forth above and should be reviewed and reversed by this Court.

IV.

Public Importance of Questions Raised.

The questions of patent law adjudicated by the Courts below and made the basis of this petition are of far reaching consequence and unusual public importance, vitally affecting all patents based on machines or their operation, probably the most numerous of all types.

According to the decisions of the Courts below, a patent satisfies the requirements of R.S. Sec. 4888, if it describes a machine and gives directions by which the machine can be made to work, *i.e.*, "tells how to work it," as the Court of Appeals said in its first opinion. It matters not that a patent fails to explain the manner in which the machine operates or, as in the instant case, does so erroneously and claims the invention only in terms of the erroneous explanation.

The decisions thus render nugatory the requirement of the statute that in the case of a machine the patent "shall explain the principle thereof . . . so as to distinguish it from other inventions." For the statute provides in addition that the "manner and process of . . . using" a machine shall be explained, which is all that the Courts below have held is meant by the requirement that the *principle* of the machine shall be explained.

It is believed that this interpretation of R.S. Sec. 4888, is not in accordance with the intention of Congress expressed in the statute, and changes the law as it had theretofore been understood. Certainly, the question herein raised of the propriety of this interpretation, which has not heretofore been decided by this Court, is of vital consequence to all owners of, and applicants for, patents based

on machines or their operation and to all who manufacture, deal in or use machines.

The immediate public interest in the requirements of R.S. Sec. 4888, is evidenced by the proposals recently made by the Milwaukee Patent Law Association and which were under consideration by the American Bar Association at its 1948 annual meeting (Reported in the American Bar Association Committee Reports, Annual Meeting, September 5-7, 1948, Section of Patent, Trade Mark and Copyright Law). As proposed by the Milwaukee Association, the statute would be amended to omit any requirement that the principle of a machine shall be explained, on the ground that it adds nothing to the other requirements of the statute (*ibid.*, p. 27). The American Bar Association Committee having the proposals under consideration was in disagreement with the Milwaukee Association (*ibid.*, pp. 27-28). This is believed to indicate clearly that, whatever import this provision of the statute may have, the Patent Bar is in doubt as to its significance. There appears to be no decision or utterance of this Court that clearly establishes the meaning of the requirement of the statute that a machine *principle* shall be explained, and it is submitted that in the absence of guidance from this Court the Patent Bar is unable safely to advise and to assist in the proper preparation of patent applications for machines and in the interpretation of machine patents.

Likewise of vital importance to all who are concerned with machines and patents therefor are the questions herein raised of the propriety of the extraordinary liberties of interpretation in which the Courts below have indulged in order to hold valid and infringed means-function claims in which the function is wrongly stated, particularly in view of this Court's apparently contrary admonitions in the Halliburton case.

V.

Conclusion.

We respectfully submit that this petition presents questions of law of the utmost importance, affecting the scope of the patent laws and patent rights, which have not been, but should be, settled by this Court, or which are contrary to previous decisions of this Court; that the interpretation which the Courts below have placed on R.S. Sec. 4888 is not in accordance with the intention of Congress as expressed in that statute, nor in the best interest of the public; and that the writ should be granted in order that this Court may authoritatively pass upon these questions.

Respectfully submitted,

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